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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/671,674	09/27/2000	Yoshiaki Komma	041-1714BRI	7384

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EXAMINER
HENRY, JON W

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/671,674	Applicant(s) KOMMA ET AL.	
	Examiner Jon W. Henry	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-132* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-132* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Reissue Applications

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support reissue examination in this application is not an error upon which a reissue can be based. Applicants' declaration solely recites as statutory error: "At least one claim depending from a subsequently issued claim was cancelled during prosecution." (1) With regard to the claims submitted in reissue, that alleged "error" is not sufficient for reissue examination according to *In re Weiler*, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986). (2) That alleged "error" is insufficient in specificity.

With regard to item (1), the alleged error, "At least one claim depending from a subsequently issued claim was cancelled during prosecution" clearly does not support reissue examination of claims 86-132 that are drawn to inventions with separate features defining "entirely distinct" inventions in accordance with *In re Weiler*, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986). No linking claim, allowable or otherwise, has been presented to suggest the inventions claimed in the patent have unity of invention with the inventions claimed in the claims newly presented in reissue. In fact, it appears the patentability of the claims newly presented in reissue and the patent claims, if any, is related to separate features of the inventions of the patent claims and the claims newly presented in reissue. That is, the common subject

matter of the patent claims and claims newly presented in reissue do not appear to define a patentable invention. Therefore, the claims newly presented in reissue appear to relate to subject matter "entirely distinct" from anything earlier claimed or attempted or intended to be claimed. See *In re Weiler*, 790 F.2d 1581, ____, 229 USPQ 673, 675 (Fed. Cir. 1986).

Applicants' declaration does not address how (a) the inventions newly claimed in reissue are not directed to "entirely distinct" inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (b) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but *Weiler* is not controlling case law in this instance. Therefore, it appears applicants' declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, ____, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

It is noted recent federal rule changes now allow restriction requirements in reissue. See 37 CFR 1.176. Those changes do not affect this application because it was filed before implementation of those rule changes on November 7, 2000. However, even if the application were filed later, that would not change the conclusion in this case because the decision in *Weiler* was not based on the federal rules but rather on the reissue statute, 35 U.S.C. 251, regarding what constitutes statutory error. The court's interpretation of the statute in that regard controls an agency's interpretation of a statute as set out in *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d, 1152, 1154 (Fed. Cir. 1988):

> Of course, an agency's interpretation of a statute it administers is entitled to deference, *Chevron USA*, 467 U.S. at 844, but the courts are the final authorities on issues of statutory construction. They must reject

> administrative constructions of the statute, whether reached by adjudication or by rulemaking, that are inconsistent with the statutory mandate or that frustrate the policy that Congress sought to implement. *FEC v. Democratic Senatorial Campaign Committee*, 454 U.S. 27, 32 (1981).

With regard to item (2), the alleged "error," "At least one claim depending from a subsequently issued claim was cancelled during prosecution," fails to specify what claims related to the prosecution history are considered by applicants to support the finding of statutory error in this case. Without such specificity, it is impossible for the examiner to check the accuracy of the statement in regard to establishing statutory error.

Claims 1-132 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above.

Response to Request for Reconsideration

3. Applicants' remarks demonstrate a lack of understanding of *In re Weiler*. In lieu of definitively addressing that decision that mandates a rejection in this application, applicants explain how their reissue application satisfies the requirements set forth in *In re Amos*, that was decided after *In re Weiler* (the same requirements that were set forth in *In re Hounsfield*, that was decided before *In re Weiler*). *Hounsfield and Amos* concerned the PTO eviscerating the reissue statute by requiring an applicant to demonstrate an "objective intent to claim" an originally disclosed invention to support reissue. Because it would be very difficult, or impossible, for an applicant to demonstrate such an "objective intent to claim" without triggering the "recapture doctrine," applicants were "caught between a rock and a hard place" in trying to obtain reissue

examination. The Federal Circuit reversed the PTO decisions in both cases. In fact, it is incomprehensible why the PTO ignored *Hounsfield* during the prosecution of the *Amos* reissue application.

However, neither *Amos* nor *Hounsfield* concerned the issues of "entirely distinct" inventions newly claimed in reissue that this case, like *Weiler*, concerns. As set forth above:

Applicants' declaration does not address how (a) the inventions newly claimed in reissue are not directed to "entirely distinct" inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (b) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but *Weiler* is not controlling case law in this instance. Therefore, it appears applicants' declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, ____, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.